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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,360	12/11/2001	Jean-Claude Pailles	214946US2PCT	9239
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER	
			WORJLOH, JALATTEE	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			10/14/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

09/926,360

Applicant(s)

PAILLES ET AL.

Examiner

Jalatee Worjloh

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-13-2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No.(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No.(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed September 13, 2010.
2. Claims 23-37 are pending.

Response to Arguments

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 23-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-37 are are considered hybrid claims. See MPEP §2173.05(p) II.

In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.. For example, claim 23 recites " A system." In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicant(s) to claim a product claim. Alternatively, claim 23 also recites " the message and payment processing system generating". One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicant(s) to claim a process claim. In light of this conflicting evidence, a

person of ordinary skill in the art could reasonably interpret claim 23 to be drawn to both a product or process.

Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicant(s) would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicant(s) overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn. For examination purposes, the Examiner will interpret claims 23-37 as claims directed to a product only.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system, but subsequently the claims then deal with the specifics of a method (the steps) executed by the processing means (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of

invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23-26, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6226618 to Downs et al. ("Downs") in view of US Patent No. 6813718 to Colvin.

Referring to claim 23, Downs discloses a terminal configured to access software stored on a computer readable storage linked thereto, the terminal including: control means for determining a payment based on previous use of the software (see col. 7, lines 5-10 -control and enforcement of content usage according to the conditions of purchase or license, such as number of plays), the terminal being configured to generate and transmit an offer message containing at least an identity of a software owner, offer parameters and a digital signature of the software owner for at least part of the offer parameters (see col. 18 table, steps 130-135; col. 7, lines 56-67 - the digital content store offers the digital content which is part of the content SC; the license key allows the user continues use of the content), a payment module linked to the terminal and configured to receive the offer message, display the offer message, receive an acceptance from the software user, generate a payment request message requesting payment, the payment request message including at least the identity of the user, and of the software owner together with proof

of the user acceptance, and configured to transmit the payment request message (see col. 18, step 136 - the user adds the digital content to his shopping card and submits it), a message and payment processing system (i.e. clearinghouse) configured to receive the payment request message, verify the proof of user acceptance, record the payment request with at least the identity of the user and of the software owner and the amount to be paid, credit the owner with the amount to be paid, the message and payment processing system generating a payment settlement message containing at least the identity of the message and payment processing system and a digital signature for proof of payment, and to transmit the payment settlement message therefrom (see col. 19, steps 137 & col. 23, lines 56-67; col. 24, lines 1-4 - transaction SC & Offer SC). Downs does not expressly disclose periodically determining a payment for continued use of the software and authorizing continued use of the software program upon verification. Colvin discloses the missing feature of Downs (see abstract; fig. 2, fig. 3; col. 2, lines 24-28, 42-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Downs to include the features of Colvin. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized usage of the software.

Referring to claim 24, Downs discloses the system whereby the digital signature of the owner of at least part of the offer, and the digital signature for proof of payment are both public key signatures with certification trees, so that an authority defines the root of the certification tree containing the system's different participants, notably a software owner and the message and payment processing server, and one or more certificates are attached to the offer and payment

settlement message for signature checking (see col. 13 & col. 14 - "Digital Signatures" and "Digital Certificates").

Referring to claim 25, Downs discloses whereby the message and payment processing server further comprises: a remote payment server linked to the payment module by a telecommunications network, and whereby said remote payment server receives and processes the payment request message and composes and sends the payment settlement message; the remote payment server calculates a total consumption of each user for all software owners in order to impose payment by said user and causes the sums owned to each software owner to be transferred by all of the users.

Referring to claim 26, Downs discloses wherein the message and payment processing server further comprises: secure means for receiving the payment request message, the secure means containing at least the identity of the user; the secure means checking the proof of the user acceptance, the secure means recording the payment request and composing the payment settlement message, the secure means transferring the payment settlement message, and the secure means including a remote payment server to credit the software owner (see claim 23 above).

Claims 36 and 37 are rejected on the same rationale as claim 23 above.

8. Claims 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and Floyd as applied to claim 26 above, and further in view of US Patent No. 6105008 to Davis et al. ("Davis").

Referring to claims 27-31, 33 and 34, Downs discloses the feature of claim 26. However, Downs does not expressly disclose wherein the secure means include a smart card reader with a smart card containing the identity of the user identity, the reader and card receiving the payment request message, checking the proof of the user acceptance, recording the payment request and generating the payment settlement message. Davis discloses a secure means include a smart card reader with a smart card containing the identity of the user, the reader and card are the payment request message, checking the proof of the user acceptance, recording the payment request and generating the payment settlement message, wherein the card is a prepaid card and contains a balance and wherein the card debits the balance with the request amount at each payment request, wherein the prepaid card message is inserted into the payment settlement message as proof that the requested amount has been debited from the card, wherein the prepaid card updates a file containing settled requests and corresponding amounts, and wherein a payment settlement message is only sent upon update of the file, wherein the prepaid card transfers the file to the remote payment server during the topping-up process, transferring funds to the software owners; wherein the card is of post-pay card, wherein the post-pay card updates a file containing settled request and corresponding amounts, and the payment settlement message is sent upon update of the file (see abstract & col. 7, lines 53-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the Downs to include the features of Davis. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by ensuring that only confirmed payments are settled.

Referring to claims 32, Downs discloses the system of claims 28. Downs does not expressly disclose a wallet. Davis discloses the prepaid card is an electronic wallet card (see col.

7, lines 40-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs to include a wallet. One of ordinary skill in the art would have been motivated to do this because it wallets are an efficient means of storing user's payment information, certificate and shipping information for fast transactions.

Referring to claim 35, Downs discloses wherein the file is transferred to the remote payment server for transferring funds to the software owners (see claim 23 above).

Conclusion

9. Functional recitation(s) using the word “for” or other functional language (e.g. “in order to”, “able to”, “to determine”) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

10. Although the conditional elements have been considered, Applicant is reminded that

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

11. A wherein clause merely that expresses the intended results does not limit the claim and is not given patentable weight (see MPEP 2111.04)

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

although all limitations must be considered, not all limitations are entitled to patentable weight).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685